

REMARKS

This paper is responsive to the Office Action mailed January 23, 2008. Claims 1-69 were pending before submission of this paper and stand rejected. Claim 47 has been amended. Claims 70-72 are newly added. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. Claims 1-72 are currently pending. Reconsideration of the claims in view of the amendments and the following remarks is respectfully requested.

Claim Rejections Under 35.U.S.C. § 101

The Office Action rejected claims 47-69 under 35.U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Office Action rejected claims 47-69 because the claims recite a computer program product that does not appear to provide a tangible result. Without conceding the merits of the rejection, Applicants respectfully submit that the amended claims overcome the rejections.

Claim 47 has been amended such that the claim is now directed to statutory subject matter. Specifically, claim 47, as amended, recites in part a "computer program product for accessing a portion of recorded information using a paper document, the computer program product comprising: a computer-readable storage medium having stored thereon computer program code..."

Accordingly, Applicants respectfully submit that the rejection of claims 47-69 under § 101 is overcome. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim Rejections Under 35.U.S.C. § 103

The Office Action rejected claims 1-3, 10-13, 16, 18-26, 33-36, 39, 41-49, 56-59, 62 and 64-69 under 35.U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0024975 to *Rajasekaran* in view of U.S. Patent No. 7,280,738 issued to *Kauffman*. Without conceding the merits of the rejection, Applicants respectfully submit that the claims overcome the rejections.

Independent claim 1 recites a method. Independent claim 24 recites a system comprising a processor and memory. The processor is operated according to the method recited in claim 1. Independent claim 47 recites a computer program product. The program code includes code that causes a processor to operate according to the method recited in claim 1. The following discussion is centered around limitations recited in claim 1. The remarks apply equally to independent claims 24 and 47.

The Office Action states:

Kauffman and Rajasekaran are both systems that allow the user to select an item that contain a machine readable code that instructs the computer to perform a function. Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Rajasekaran and Kauffman in front of them, to modify the timestamps of Kauffman to include a process to computer (sic) timestamps to determine a range between the timestamp labels. Kauffman suggests the combination through the teaching of allowing or providing a system that segments video in an archive to allow a user to access the content and select items for review during the compilation of a storyboard to other video production processes (See column 1, lines 40-52). Further, Kauffman teaches the direct process of accessing a code from a medium where the code is read via an OCR or watermark reader, which can comprise codes that describe content or location of content.

The ultimate determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). A case of obviousness requires ascertaining the scope and contents of the cited references, and ascertaining the differences between the cited references and the claims at issue, as well as the level of ordinary skill in the art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966); *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727. While specifically demonstrating a teaching, suggestion, or motivation to combine references is not strictly required, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Intern. Co. v. Teleflex Inc.*, at 1741. And "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *Id.* at 1742.

The PTO has the initial burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The PTO can satisfy this burden by showing some objective teaching in the prior art which would have led one of ordinary skill in the art to the invention claimed. *Fine*, 837 at 1074, 5 USPQ2d at 1598. "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142. All limitations of the claimed invention must be taught or suggested by the prior art to establish obviousness. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Applicants maintain that the Examiner has failed to establish at least two of the requirements for a case of *prima facie* obviousness: 1) there is no suggestion or motivation to combine the cited references; and 2) even if combined, the cited references, alone or in combination, would fail to teach or suggest each and every element of the current claims.

In the present case, claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Rajasekaran* in view of *Kauffman*. Independent claim 1 reads as follows:

A computer-implement method of accessing a portion of recorded information using a paper document, the method comprising:
receiving information indicative of selection of one or more identifiers from a first set of identifiers printed on the paper document;
determining one or more time ranges based upon the one or more identifiers, each time range having a start time and an end time; and
determining portions of the recorded information corresponding to the one or more time ranges, wherein a portion of recorded information corresponding to a time range comprises information from the recorded information occurring between the start time and end time associated with the time range.

Applicants respectfully submit that no reasonable combination of the cited references would render the claimed invention obvious. At a minimum, the Office has failed to establish that the element of determining a time range based upon an identifier, as recited in claim 1, is taught or suggested in the cited references of *Rajasekaran* or *Kauffman*, or anywhere else in the art.

The Office Action cited *Rajasekaran* for teaching:

receiving information indicative of selection of one or more identifiers from a first set of identifiers printed on the paper document; [and]

determining one or more time ranges based upon the one or more identifiers, each time range having a start time and an end time

Specifically, the Office Action states:

Rajasekaran teaches reading a timestamp that can have a temporal event that occurs periodically or randomly. *Rajasekaran* teaches the timestamp can be read to facilitate the display of content related to the timestamp. Therefore, a timestamp can have a beginning or end time. For example, *Rajasekaran* teaches a user interface that allows a user to view a catalog with an index. The index can be searched by scanning for an ID on a label. Therefore, images can be stored in a folder or index based on timestamps and scanning an index for a picture with a beginning and end time can be performed (See Para 0090 and 0095-96). The timestamp label is read from a paper medium via a barcode (See Para 0099).

Contrary to the examiner's conclusion, *Rajasekaran* does not teach each of the recited limitations of independent claim 1. *Rajasekaran* does not disclose determining a time range based on the timestamp because a timestamp provides no indication, or otherwise, represents a time range. A timestamp, as the name implies simply identifies a specific point in time, a timestamp does not have a beginning or an end time.

Rajasekaran's discussion of timestamps does not constitute determining time ranges based on selected identifiers. As best understood, *Rajasekaran* discloses using a timestamp generated by a clock on a mobile device as an object identifier associated with media content. For example, the time at which the object identifier is scanned determines the media content that is associated with the object identifier. (See paragraphs [0042] and [0063]). However, there is no discussion of determining time ranges based on selected identifiers. The mere mention of a timestamp that is associated with an object identifier can not be fairly construed to disclose determining time ranges based on selected identifiers. As such, *Rajasekaran* fails to teach or suggest "receiving information indicative of selection of one or more identifiers from a first set of identifiers printed on the paper document; [and] determining

one or more time ranges based upon the one or more identifiers, each time range having a start time and an end time," as recited in claim 1.

The Office Action cited *Kauffman* for teaching:

determining portions of the recorded information corresponding to the one or more time ranges,

wherein a portion of recorded information corresponding to a time range comprises information from the recorded information occurring between the start time and end time associated with the time range.

Specifically, the Office Actions states:

Kauffman teaches a process of corresponding one or more time codes where the recorded information occurs between a start time and an end time (See column 5, lines 24-50 and column 10, lines 50-67 and column 11, lines 1-5). *Kauffman* teaches the frame can be selected by detecting its time code that can be input by an OCR tool or a watermark, which are examples of processes that read from a physical document and convert to a digital format.

Kauffman does not disclose determining a portion of recorded information corresponding to a time range. In *Kauffman*, time codes and frame numbers of frames in a video stream in one file format are used to determine the time code of other frame numbers in the video stream. By determining a correspondence between time codes and frame numbers of the video stream, specific frames may be located in the video stream having a different file format.

As described in the present application, a server receives information representative of specified ranges and operations to be performed on the ranges from a scanning device. Based on the information identifying the ranges, the server accesses one or more multimedia documents storing recorded information and determines portions of the recorded information corresponding to the specified ranges. (See paragraph [0277]).

Kauffman's description of his video stream calibration does not teach determining a portion of recorded information corresponding to a time range. As best understood, *Kauffman* discloses calibrating two different file formats of the same video stream. (See Column 5, lines 22-50). However, there is no discussion of determining a portion of recorded information corresponding to a time range. The mere mention of calibrating different formats of a video

stream can not be fairly construed to disclose determining a portion of recorded information corresponding to a time range. As such, *Kauffman* fails to teach or suggest "determining portions of the recorded information corresponding to the one or more time ranges, wherein a portion of recorded information corresponding to a time range comprises information from the recorded information occurring between the start time and end time associated with the time range," as recited in claim 1.

A case of obviousness requires ascertaining the scope and contents of the cited references, and ascertaining the differences between the cited references and the claims at issue, as well as the level of ordinary skill in the art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In the present case, against this background, Applicants respectfully maintain that a case of obviousness in view of the cited references would not be found because not only would the proposed combination fail to teach the claimed invention, but the calibration of a video stream in the teachings of *Kauffman* do not provide any benefit to the proposed combination, i.e., modifying the timestamp of *Rajasekaran* with the teachings of *Kauffman* to include a video calibration technique.

Neither *Rajasekaran*, *Kauffman* nor any of the other cited references, alone or in combination, teach all of the features recited in independent claim 1. Specifically, *Rajasekaran* and *Kauffman* do not teach "receiving information indicative of selection of one or more identifiers from a first set of identifiers printed on the paper document; [and] determining one or more time ranges based upon the one or more identifiers, each time range having a start time and an end time." *Rajasekaran* and *Kauffman* also do not teach "determining portions of the recorded information corresponding to the one or more time ranges, wherein a portion of recorded information corresponding to a time range comprises information from the recorded information occurring between the start time and end time associated with the time range." For at least these reasons, claim 1 is allowable over the cited art.

Independent claims 24 and 47, as amended, recite features that are similar to the features recited in amended claim 1. As discussed above with reference to claim 1, the cited art does not teach these features. Thus, claims 24 and 47 are also allowable over the cited art for at least the same reasons.

Furthermore, claims 2, 3, 10-13, 16 and 18-23 are dependent on claim 1, claims 25, 26, 33-36, 39 and 41-46 are dependent on claim 24, and claims 48, 49, 56-59, 62 and 64-69 are dependent on claim 47. As discussed above, claims 1, 24 and 47 are allowable. Thus, claims 2, 3, 10-13, 16, 18-23, 25, 26, 33-36, 39, 41-46, 48, 49, 56-59, 62 and 64-69 are also allowable for at least the same reasons that claims 1, 24 and 47 are allowable, as well as on their own merits.

The Office Action rejected claims 14, 15, 17, 37, 38, 40, 60-61, and 63 under 35.U.S.C. § 103(a) as being unpatentable over *Rajasekaran* and *Kauffman* in view of U.S. Patent No. 6,152,369 issued to *Wilz*. The Office Action rejected claims 4-9, 27-32, 50-55 under 35.U.S.C. § 103(a) as being unpatentable over *Rajasekaran* and *Kauffman* in view of U.S. Patent No. 6,931,594 issued to *Jun*. Without conceding the merits of the rejection, Applicants respectfully submit that the amended claims overcome the rejections.

Claims 4-9, 14, 15 and 17 depend from claim 1, claims 27-32, 37, 38 and 40 depend from claim 24, and claims 50-55, 60, 61 and 63 depend from claim 47. The rejection of claims 4-9, 14, 15, 17, 27-32, 37, 38, 40, 50-55, 60, 61 and 63 is premised on the assertion that *Rajasekaran* and *Kauffman* disclose the features recited in claims 1, 24 and 47, and one of *Wilz* and *Jun* discloses the remaining features of claims 4-9, 14, 15, 17, 27-32, 37, 38, 40, 50-55, 60, 61 and 63.

As discussed above, however, *Rajasekaran* and *Kauffman* do not disclose or suggest all features recited in amended claims 1, 24 and 47. As best understood, *Wilz* and *Jun* do not provide any teaching or suggestion that would remedy this deficiency. Therefore, the rejection is based on a flawed premise and cannot be maintained. Applicants respectfully request withdrawal of the rejection of claims 4-9, 14, 15, 17, 27-32, 37, 38, 40, 50-55, 60, 61 and 63.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-69.

New Claims

Claim 70-72 are newly added. The newly added claims describe features of the invention that are not disclosed in the cited references. Thus, Applicants respectfully request allowance of new claims 70-72.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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